

REMARKS

Claims 1 to 15 as set forth in Appendix II of this paper are herewith presented for further prosecution in this case. Relative to the version of claims previously before the Examiner, Claim 1 has been amended, and Claims 8 to 15 have been added, as indicated in the listing of the claims.

More specifically, applicants have clarified Claim 1 to bring out that the compound (I) is applied together with at least one phytotoxic agrochemical.²⁾ Claims 8 to 15 have been added to further bring out the embodiments of applicants' method mentioned on page 3, indicated lines 32 to 34, and on page 12, indicated lines 12 to 19, of the application. No new matter has been added.

Additionally, applicants have amended the paragraph on page 12, indicated lines 12 to 19, of the application to render the URL non-executable. Accordingly, it is respectfully requested that the Examiner withdraw the objection to the specification. Favorable action is respectfully solicited.

The Examiner rejected Claims 1 to 6 under 35 U.S.C. §112, ¶2, as being indefinite arguing that it was unclear how resistance of the plants to phytotoxicity was increased.³⁾

Whether a claim meets the definiteness requirements of Section 112, ¶2, requires a determination whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.⁴⁾ As a general matter, it is well-established that the determination whether a claim is invalid as indefinite depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification.⁵⁾ Also, the purpose of the claim is not to explain the technology or how it works, but to state the legal boundaries of the patent grant, i.e., a claim is not "indefinite" simply because it is hard to understand without benefit of the specification.⁶⁾ The standard for assessing whether a patent claim is sufficiently definite to satisfy the statutory requirement is as follows: If one skilled in the art would understand the bounds of the claim when read in light of the specification, then the claim satisfies Section 112, ¶2.⁷⁾ Moreover,

In rejecting a claim under the second paragraph of 35 U.S.C. 112, it is incumbent on the

2) Cf. page 12, indicated lines 1 to 10, of the application.

3) Office action page 2, lines 17 to 21.

4) *Morton International, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 28 USPQ2d 1190 (Fed. Cir. 1993), *on remand from*, 508 U.S. 83, 26 USPQ2d 1721 (1993).

5) *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999); see also *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1579, 28 USPQ2d 1333, 1339 (Fed. Cir. 1993); *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

6) *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 59 USPQ2d 1745 (Fed. Cir. 2001); cf. also *Autogiro Co. of America v. United States*, 384 F.2d 391, 397, 155 USPQ 697, 701 (Cl. Ct. 1967) (a claim cannot be interpreted without going beyond the claim itself).

7) *Exxon Research & Engineering Co. v. United States*, 256 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001); see also *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.^[8]

Applicants' claims pertain to a method which *inter alia* comprises treating certain targets, i.e., plants, their environment or seeds, with an effective amount of a compound (I) and with a phytotoxic agrochemical, and the method achieves that the resistance of the plants against the phytotoxic effects of the agrochemical is increased. As such, applicants' claims clearly fully apprise a person of ordinary skill in the art of the steps which are to be taken in order to arrive at the result of increasing the resistance of plants to the phytotoxicity of other crop protection products. The Examiner's criticism that it is unclear *how* the resistance of the plants to phytotoxicity is increased is, therefore, deemed to be without reasonable basis.

Further, applicants respectfully draw the Examiner's attention to the explanations provided in the supporting specification. For example, the sections on page 3, indicated line 32, to page 4, indicated line 14, and page 11, indicated line 36, to page 19, indicated line 46, of the application specifically address the meaning of the expressions "increase of resistance," "phytotoxicity" as well as "crop protection products."

In light of the foregoing it is respectfully urged that the Examiner's position is in error. Favorable reconsideration and withdrawal of the respective rejection is therefore respectfully solicited.

Additionally, the Examiner provisionally rejected Claims 1 to 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable in light of Claims 1 to 3 of application Serial No. 10/257,874 (Köhle et al.) when taken in view of the disclosure of *Heinemann et al.* (WO 97/27189).

The Examiner alleged in this context that application Serial No. 10/257,874 was co-pending. It is, however, respectfully submitted that the status of the application as of July 28, 2004, is "Abandoned -- Failure to Respond to an Office Action."^[9] Withdrawal of the provisional rejection under the doctrine of obviousness-type double patenting is therefore respectfully solicited.

It is also respectfully noted that the claims of *Köhle et al.* taken alone or taken in view of the disclosure of *Heinemann et al.* cannot be deemed to render applicants' method unpatentable under the doctrine.

8) *Ex parte Wu*, 10 USPQ2d 2031 at 2033 (BPAI 1989).

9) Cf. PAIR information.

According to long-standing holdings of the Courts, a double patenting rejection of the obviousness type is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. §103 except that the reference underlying the double patenting rejection is not considered prior art. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination.¹⁰⁾ *“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”*¹¹⁾ The Supreme Court recently emphasized the need *“to determine whether there was an apparent reason to combine known elements in the fashion claimed by the patent at issue.”*¹²⁾ To establish a prima facie case of obviousness it is, therefore, essential that there be some motivation or suggestion to make the claimed invention in light of the prior art teachings.¹³⁾ *“[A] proper analysis under §103 requires, inter alia, consideration of ... whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process.”*¹⁴⁾

The claims of *Köhle et al.* pertain to a certain method which entails treating plants, soil or seeds with effective amounts of a certain compound, whereas applicants' method requires that the compound (I) be *“applied together, that is before, after or concomitantly, with at least one phytotoxic agrochemical.”* Applicants' method, accordingly, differs from the method of *Köhle et al.* at least in the measures which are to be taken to achieve the sought result.

Moreover, the method of *Köhle et al.* aims at *“inducing virus resistance of plants”* whereas applicants' claims define a method of *“increasing the resistance of plants to the phytotoxicity of other crop protection products.”* Applicants' claims, accordingly, further differ from the claims of *Köhle et al.* in the effect which is achieved by the measures which are set forth in the claims. It is well settled that not only the materials used and the nature of the specific process employed but

10) *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Braat*, 837 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

11) *Graham v. John Deere*, 383 U.S. 1, at 17 – 18, 148 USPQ 459 (1966). Cf. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007), Slip op. at 2.

12) *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ____ (2007), Slip op. at 14.

13) See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) (“[T]he mere possibility that one of the esters or the active methylene group-containing compounds . . . could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious “unless the prior art suggested the desirability of [such a] modification” or replacement.”) (quoting *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

14) *In re Vaec*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

also the particular result which is obtained must be considered when determining whether a claimed method is obvious within the meaning of Section 103.¹⁵⁾ Inherence of an advantage or property and its obviousness are entirely different questions, an inherent advantage or property is not necessarily known or apparent to a person of ordinary skill in the art and obviousness cannot be predicated on what is unknown.¹⁶⁾

The Examiner alleged:¹⁷⁾ *“The action of the method is inherently taught, because both applications pertain to improved resistance of the plant. The fact that one form of resistance is for viruses and the other phytotoxicity does not make them patentably distinct because both methods are used on plants.”* Applicants respectfully urge that a virus cannot reasonably be deemed to be equivalent to a phytotoxic agrochemical. Without more, the Examiner’s allegation therefore cannot be deemed to support that applicants’ method was obvious in light of the method of *Köhle et al.* It is also noted that the Examiner did not explain how the disclosure of *Heinemann et al.* was deemed to contribute to the reasons for rejecting applicants’ claims under the doctrine of obviousness-type double patenting. However, *“rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”*¹⁸⁾ The Examiner’s arguments are deemed to lack the rational underpinning which is necessary to support the conclusion of obviousness. Accordingly, even if the application of *Köhle et al.* were co-pending, which is not the case, the Examiner’s respective rejection would be deemed to be in error.

In light of the foregoing it is respectfully requested that the rejection of Claims 1 to 6 under the judicially created doctrine of obviousness-type double patenting be withdrawn. Favorable action is respectfully solicited.

15) *In re Dillon*, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (Fed. Cir. 1990) (*en banc*), *cert. denied*, 500 U.S. 904 (1991).

16) *In re Adams*, 356 F.2d 998, 148 USPQ 742 (CCPA 1966); *In re Spormann*, 363 F.2d 444, 150 USPQ 449 (CCPA 1966); *In re Shetty*, 566 F.2d 81, 195 USPQ 753 (CCPA 1977); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).

17) Office action page 4, lines 6 to 9.

18) *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).